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D.   Remarks

Rejection of Claims 1-12, 14 and 16 Under 35 U.S.C. §103(a) based on *Baratz et al.* (U.S. Patent No. 5,742,596) in view of *Crowley et al.* (U.S. Patent No. 5,410,599).

5   The rejection of claims 1-5 and 11-12 will first be addressed.

The invention of amended claim 1 is directed to a voice and data network that includes a) a telephone and a computer connected to a voice and data module (VDM) device. The telephone and computer having unique assigned network addresses with respect to one another. Also included is a plurality of said VDM devices connected to a plurality of telephone wires in a

10   building. The plurality of telephone wires is connected together to provide a telephone network in which only one phone can communicate on a given line at one time. A link to wide area network (LTW) connects said telephone network to a Public Service Telephone Network (PSTN) and an Internet Service Provider (ISP). The LTW and plurality of said VDM devices communicate together over said telephone network using communication addresses assigned to

15   said LTW and each VDM device.

As is well established, to establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.

20   The rejection indicates that *Baratz et al.* does not teach or suggest all of Applicant's claim 1 limitations:

> Baratz does not disclose the telephone and computer having unique assigned network
> addresses with respect to one another. (Office Action, dated 02/24/05, Page 3, Lines 14-

25   > 15).

To show such a limitation, the rejection proposes modifying *Baratz et al.* in view of *Crowley et al.* In particular, the rejection believes that *Crowley et al.* shows/suggests the above claim 1 limitation:

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> Crowley teaches... a.. voice and data module device (V/DED)... that is placed between
> the telephone communication equipment... and a computer (inherently, any calls from

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the outside going to particular phone or computer *must* have unique assigned network addresses with respect to one another). (Office Action, dated 02/24/05, Page 3, Lines 16-21, emphasis added).

5   Applicant respectfully disagrees.

Applicant does not believe that the reference *Crowley et al.* teaches or suggests the above limitations, as argued by the rejection. First, the reference never mentions any network address. A word search of the *Crowley* reveals only one occurrence of the word "address" and it is entirely unrelated to a network address, but rather some bus-memory connection:

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> The side of the common bus of the V/DED structure provides a common path for the power, DMA interface control, memory, address and Input output connections. (*Crowley et al.*, Col. 4, Lines 1-4).

15   Thus, because the reference makes no mention of any network address, it is not understood how the reference can show or suggest "telephone and computer having unique assigned network addresses with respect to one another", as recited in claim 1.

Second, the rejection rationale is not believed to be sufficient to establish a prima facie showing. Reliance upon inherency cannot be based on mere assertion without specific direction

20   to the relevant reference:

> [W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. (*Ex Parte Schricker*, 56 USPQ 2d 1723, 1725 (B.P.A.I. 2000)) Compare *In re Rijckaert*, 9 F.3d 1531, 1533,
25   28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art) (citing *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981)).

30   The above quoted rationale has provided no indication as to where "network address" teachings are presented, and only describes phone and computer connections to a V/DED. Accordingly, the reference has not presented a factual showing sufficient to support a prima facie case of obviousness.

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Finally, Applicant believes the statement is not true. The rejection reasoning states that inherently, any calls from the outside going to particular phone or computer <u>must</u> have unique assigned network addresses. The reference explicitly contradicts this reading:

5   It is important to note that until such time as a user desires secure communications, the V/DED is in a 'by-pass' mode. that is, *analog* or digital signals go directly to the PSTN or are transmitted over a cellular network without being processed by the V/DED. (*Crowley et al.*, Col. 6, Lines 28-32, emphasis added).

10   The above shows that a V/DED can be an analog device (conventional PSTN phone) and thus would not transmit data according to any network address. Thus, because the cited reference explicitly contradicts the rejection interpretation of the reference, a prima facie case of obviousness cannot have been established.

In addition or alternatively, it is equally well settled that rejections which combine

15   references must show some teaching, suggestion, or motivation to do so <u>found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.</u>

The rejection rationale relies on the following reasoning to combine *Baratz et al.* in view of *Crowley et al.*:

20   It would have been obvious... to use the teachings from Crowley... to the computer and telephone of Baratz. One... would have been motivated... because [the modification]... provides the telephony devices to implement the same features so that there is a redundant capability. (Office Action, dated 02/24/05, Page 4, Lines 1-7).

25   This motivation (providing redundant capability) is not from either reference. Applicant can find no mention of redundancy in either reference (a word search of redund$, where $ indicates a wild card value, yields no results). If the Examiner is taking official notice with respect to such teachings, Applicant seasonably traverses this statement and requests the citation of references in support.

30   Thus, absent any reference provided to support a taking of official notice, the necessary motivation for a prima facie case of obviousness has not been presented.

For all of these reasons, this ground for rejection is traversed.

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Claims depending from claim 1 are believed to be separately patentable over the cited reference.

Claim 3, which depends from claim 1, recites that an LTW and VDM devices communicate over said network of telephone wires by means of <u>Token in Ethernet Protocol</u>

5   <u>technology</u>. Token in Ethernet Protocol is a particular protocol set forth in U.S. Patent 6,751,213. No such protocol is shown or suggested in the cited references. Accordingly, such a limitation is not in the cited reference.

Claim 11, which depends from claim 1, recites that the voice and data network is organized into at least two VDM locations. Each VDM location includes a VDM device having

10 a first network address, a first connection for a device that is assigned a second network address, and a second connection for a device that is assigned a third network address. The first, second and third network addresses are different from one another.

The rejection cites *Baratz et al.* to show such limitations:

15   Baratz discloses... each host computer has a voice and data module with a computer and
        phone connected thereto... the devices in the network communicate using the Ethernet
        protocol and thus have unique addresses since Ethernet requires it... (Office Action,
        dated 02/24/05, Page 4, Lines 1-7).

20 Applicant must respectfully disagree with this reading of the reference. Applicant has previously noted that in *Baratz et al.* phones are connected to the network <u>through</u> host computers by way of network interface cards (NICs).
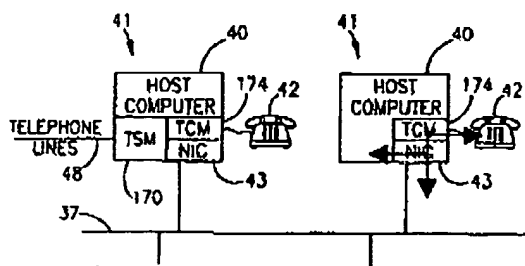
Both phone (42) and
host computer (40)
access network (37)
through NIC (43).

25 Consequently, in *Baratz et al.*, the phones do not have separate network addresses. Phones have <u>extensions</u>, but such extensions are related to the NIC address, as noted in the reference.

The physical extension numbers are directly related to the *unique network address of the host computer 40 that telephone set 42 is connected to*. In a similar manner telephones connected to a remote subscriber interface module are assigned unique physical address. (*Baratz et al.*, Col. 6, Lines 20-24)

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Thus, in *Baratz et al.* a telephone has the same network address as its host computer, which would seem to be the opposite of Applicant's claim 11.

Accordingly, because the rejection appears to rely on an incorrect evaluation of the reference, the rejection cannot show all the limitations of claim 11, and the claim is separately

10   patentable.

The rejection of claims 6-10, 14 16 will now be addressed.

The invention of claim 6 is directed to a method for communicating between network elements in a voice and data network. The method includes (a) monitoring a communication

15   network by a first voice and data module (VDM) for a call from a second VDM and a call from a link to a wide area network (LTW) connected to said communication network, (b) monitoring a first phone and a first computer attached to said first VDM for an outgoing call to a destination containing a second phone and a second computer connected to said second VDM, or an outside phone and an outside computer network through said LTW. The first phone has a first

20   identification (ID) value and first computer has a second ID value different from the first ID value.

The method also includes (c) detecting an outgoing call to a destination phone and connecting the call if the destination phone is not busy, else providing a busy signal and disconnecting said outgoing call. Connecting the call includes, if the destination phone is picked

25   up, converting voice signals to a packet with an ID value as a source address, the ID value being the first ID value if the outgoing call originates from the first phone and being the second ID value if the outgoing call originates from the first computer.

The method further includes (d) detecting an incoming call and connecting said call if a receiving device comprising said first phone and said first computer is not busy, else sending

30   back said busy signal and disconnecting said incoming call, and (e) disconnecting phone calls or computer calls when a phone hang up or a computer disconnect signal is detected and returning to monitoring said network for said incoming call.

As understood from the above underlined portions of Applicant's claim 6, the invention of claim 6 includes particular limitations related to ID values, and conversion of voice signals to packets with particular ID values.

These limitations were not addressed by the rejection, and thus a prima facie case cannot exist. While the rejection recites some of Applicant's claim language at Page 6, of the Office Action, no mention is made of a "first ID value", "second ID value" or "converting voice signals" as recited in claim 6. That is, the rejection has not shown where such concepts and method steps are demonstrated in either reference.

For this reason alone, a prima face case of obviousness is not believed to have been established.

To the extent that the rejection relies on the combination of *Baratz et al.* in view of *Crowley et al.*, the comments set forth above for claim 1 are incorporated by reference herein. In particular, certain reference teachings are not necessarily inherent (must be shown) in the reference and/or the requisite suggestion/motivation for a prima facie case is not present.

Claims depending from claim 6 are believed to be separately patentable over the cited combination of references.

Claim 8, which depends from claim 6, recites that communicating between computers takes place according to Token in Ethernet protocol eliminating the need for any conversion.

To address this ground for rejection, Applicant incorporates by reference herein the comments set forth for claim 2. More particularly, the rejection has argued the reference provides teachings directed to Ethernet protocol, not Token in Ethernet protocol, as recited in claim 8.

Claim 16, which depends from claim 6, recites that step d) further includes the LTW requesting an outside call to provide extension data for an incoming call, and if an extension number is not received, storing a predefined port address as a destination address in request for connection packet.

The rejection rationale appears to rely on two different rationales: (1) *Baratz et al.* allegedly includes an inherent teaching that shows Applicant's claim 16 limitations and (2) it would have been obvious to modify *Baratz et al.* to arrive at Applicant's invention of claim 16. The inherency rationale is set forth below:

[I]nherently, any calls from the outside going to a particular phone must have a phone number and/or extension associated with it so that the telephony server can properly route the call. (Office Action, dated 02/24/05, Page 10, Line 17 to Page 11, Line 1).

5   Applicant reiterates that a reliance on inherency cannot be based on mere assertion, and must afford Applicant an opportunity to understand where in the reference an alleged teaching is inherently shown. The above rationale provides no such indication, and thus cannot establish a prima facie case of obviousness.

Further, Applicant's cannot agree with the above factual assertion. Every call arriving at
10   the system of *Baratz et al.* does not necessarily (i.e., must) have an extension. *Baratz et al.* neither shows nor suggest any way of controlling which particular types of call arrive to the system.

Accordingly, because no guidance as to the location of an inherent teaching has been provided, a prima facie case based on inherency is not believed to have been established.
15   Second, because the inherent teaching does not appear supported by the reference, a prima facie case of obviousness is not believed to have been established.

Claims 16 also appears to have been rejected based on obviousness:

It would have been obvious... to implement this feature in Baratz because doing so will
20   allow the call to take place rather than dropping the call because the extension is unknown, thus making Baratz more reliable. Note: this becomes even more important for emergency calls made in the Baratz system. (Office Action, dated 02/24/05, Page 11, Lines 1-6).

25   The above motivation (added reliability and/or support of emergency calls) is not from either reference. If the Examiner is taking official notice with respect to such teachings, Applicant seasonably traverses this statement and requests the citation of references in support.

Thus, because the motivation relied upon to reject claim 16 is not from the references themselves, and is not supported by taking official notice, a prima facie case of obviousness
30   cannot have been established for this claim.

For all of these reasons, this ground for rejection is traversed.

Rejection of Claim 13, Under 35 U.S.C. §103(a) based on *Baratz et al.* in view of *Crowley et al.* further in view of *Angle et al.* (U.S. Patent No. 6,366,771).

To the extent that this ground for rejection relies on the combination of *Baratz et al.* in view of *Crowley et al.*, the comments set forth above for claim 6 are incorporated by reference

5 herein. In particular, various limitations of base claim 6 were not addressed by the rejection, reliance on inherent teachings appears unsupported, and the requisite suggestion/motivation for a prima facie case is not present.

Claim 1 has been amended, not in response to the cited art, but to correct typographical

10 errors.

The present claims 1-14 and 16 are believed to be in allowable form. It is respectfully requested that the application be forwarded for allowance and issue.

15   Respectfully Submitted,

_____ 5/19/05
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